

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 030010			
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		First Named Inventor Gregory Gordon ROSE			
		Art Unit 2432	Examiner Cordelia P. K. ZECHER		
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"><tr><td style="width: 50%; vertical-align: top;"><input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input type="checkbox"/> attorney or agent of record. Registration number _____</td><td style="width: 50%; vertical-align: top; padding-left: 20px;">/Won Tae Kim/ _____ Signature Won Tae Kim _____ Typed or printed name 858-651-6295 _____ Telephone number _____ Date</td></tr></table> <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>40,457</u>				<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input type="checkbox"/> attorney or agent of record. Registration number _____	/Won Tae Kim/ _____ Signature Won Tae Kim _____ Typed or printed name 858-651-6295 _____ Telephone number _____ Date
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.					
<input type="checkbox"/> *Total of _____ forms are submitted.					

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.: 10/752,420

Applicants: Gregory Gordon Rose, et al.

Filed: January 5, 2004

Examiner: Cordelia P. K. Zecher

Art Unit: 2432

Customer No. 23696

Confirm. No.: 3858

Docket No.: 030010

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I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office:

Depositor's Name: Cindy McClure
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PRE-APPEAL BRIEF

Filed via EFS

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Commissioner:

This Pre-Appeal Brief is filed in response to the Examiner's remarks in the Final Office Action mailed August 3, 2011. This Pre-Appeal Brief is being submitted in accordance with the requirements of the Pre-Appeal Brief Conference Pilot Program (*see* 1296 Off. Gaz. Pat. Office 67, July 12, 2005) and is being submitted concurrently with a Notice of Appeal.

DISPOSITION OF CLAIMS

Claims 1-3, 5-24, 26-28, 50, 51 and 53-68 are currently pending in the application. Claims 1-3, 5-24, 26-28, 50, 51 and 53-68 stand rejected (see, Final Action mailed August 3, 2011).

Applicants submit that there are clear errors in the rejections of the pending claims and the current rejections rely on modifications to the prior art references that are expressly contrary to the teachings in the prior art.

The current rejections of record are as follows:

Claims 50 and 56 are rejected under 35 U.S.C. §103(a) as being allegedly obvious over U.S. Patent No. 6,782,103 (hereinafter “Arthan et al.”) in view of U.S. Publication No. 2002/0071561 (hereinafter “Kurn et al.”).

Claims 1-3, 5-9, 11-14, 16-24, 26-28, 51 and 53-55 are rejected under 35 U.S.C. §103(a) as being allegedly obvious over Arthan et al. in view of Kurn et al., and further in view of U.S. Publication No. 2002/0018570 (hereinafter “Hansmann et al.”).

REMARKS

In rejecting each of the independent claims, the Final Office Action relies primarily on Arthan et al. However, because Arthan et al. does not include any disclosure of a single device including all the features of the various independent claims, the Final Office Action imports two substantial modifications into the teachings of Arthan et al. to justify the rejections. First, the Final Office Action asserts that it is obvious to modify Arthan et al. such that the distinct central system 5 is combined into the distinct source system 1 as one of the distributed nodes of the source system 1. This still fails to describe a single device (e.g., a mobile user device) that includes all the features recited in the independent claims. Thus, the Final Office Action relies on a second major modification to the already modified disclosure of Arthan et al. by combining all of the individual nodes of the source system 1, including the central system 5, into a single device.

Although the Final Office Action does not expressly identify any motivation for the proposed modifications to Arthan et al., the Final Office Action refers generally to the Office Action issued on March 24, 2011 in justifying the proposed modification. In particular, the

Office Action issued on March 24, 2011 argues that a modification decreasing the pieces of hardware (e.g., having one piece of hardware perform the task previously performed by two) is analogous to making functions, structures, or actions integral, and that it would have been obvious to one having ordinary skill in the art to make the central system 5 integral with the source system 1. *See Office Action of March 24, 2011* at p. 3. However, such modifications are patentable where the recited claims show insight that was contrary to the understanding and expectations of the art. *See MPEP* § 2144.04(V)(B); and *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). In the present case, the current claims show insight that is contrary to the understanding and expectations of Arthan et al.

Arthan et al. discloses only a single embodiment. According to that single embodiment, Arthan et al. states that it is “assumed that the example system is such that operators 3 of the source system 1 **are not authorized to handle the private key DSPR itself.**” *Arthan et al.* at col. 2, lines 35-38 (emphasis added). Arthan et al. also teaches that the management of all keys is under control of a security officer 6, who can operate the central system 5 and who uses automated or manual procedures and protocols to arrange for delivery and installation of key material. *Id.* at col. 1, lines 46-50; col. 3, lines 25-43. Arthan et al. further discloses that “the security officer can change to the version of DSPR corresponding to the spare DSPU key” (*Id.* at col. 5, lines 7-10). Thus, Arthan et al. discloses that the security officer 6 is authorized to handle private keys (DSPR) generated by the central system 5 in order to manually deliver and install the keys, as well as to change the version of the private keys, while operators 3 of the source system 1 are prohibited from handling the private keys. Since the operators 3 of the source system 1 are expressly not authorized to handle the private keys, and the security officer 6 is expressly authorized to handle the private keys, the security officer 6 cannot be an operator 3 of the source system 1. Combining the central system 5 with the source system 1 such that the user of the integrated device may both operate the device and manage keys was therefore expressly contrary to the understanding and expectations of Arthan et al.

It is noteworthy that Arthan et al. discloses only one embodiment, in which the operators 3 of the source system 1 are not authorized to handle the private keys. Although the Final Office Action argues that this is just one example, there is no other example and nothing in Arthan et al. that discloses or suggests that the operators can be authorized to handle the private keys in other

examples. Therefore, considering the disclosure of Arthan et al. as a whole, a person of ordinary skill in the art is taught only that the operators 3 of the source system 1 cannot handle the private keys, and could not also be a security officer 6.

Because the combination of the source system 1 and the central system 5 into a single device is not supported by Arthan et al., and such a modification is explicitly contrary to the understanding and expectations of Arthan et al., the proposed modifications cannot be used to justify a rejection of independent claims 1, 11, 14, 19, 22, 26, 50 and 51.

Considering the disclosure according to what is reasonably and fairly taught (e.g., without the modifications proposed by the Final Office Action), Arthan et al. fails to teach or suggest all of the features recited in the independent claims, and the additionally cited references fail to remedy the deficiencies of Arthan et al. For example, details relating to the deficiencies of each of the central system 5, the source system 1 and the destination system 2 can be found in the Response filed by Applicants on June 22, 2011 at pages 21-23, 27 and 31. In general, these portions of the previously filed response set forth the fact that the central system 5 outputs the private key for use by the source system 1 for authentication prior to using the stored spare private key. In addition, the central system 5, which generates the first and second key pairs, does not actually use any of the keys for authentication of the central system 5. These features are contrary to at least some of the features recited by the independent claims. In relation to the source system 1 and the destination system 2, Arthan et al. discloses that the source system 1 simply receives the active private key from the central system 5 and stores the private key into a volatile memory for use, while the destination system 2 simply receives the public key from the central system 5. Neither system generates any keys or outputs any keys.

Therefore, Applicants submit that there is no justification for citing Arthan et al. as teaching the features relating to creating first and second private and public keys, outputting the second private key while retaining the first private key, transmitting the first and second public keys, and using the first private key for authentication.

Although additional reasons exist for dismissing the asserted modification of Arthan et al., Applicants believe that the above described errors are adequate to justify reversal of the Final Office Action.

CONCLUSION

Applicants submit that the rejections asserted in the Final Office Action are based on an erroneous modification of the primary reference. Applicants respectfully request that the rejection of the claims on the above-identified grounds be reversed.

Respectfully submitted,

Dated: October 28, 2011

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